

REMARKS/ARGUMENTS

I. INTRODUCTORY REMARKS

Applicant thanks the Examiner for her careful consideration of the application. Claims 21-36 and 69-87 are pending in the application. By this amendment, claims 21 and 29 are amended to more particularly recite the features of the computer-readable medium for tax data collection and the method for tax data collection, respectively. Claims 37-68 are canceled without prejudice or disclaimer. Claims 1-20 were canceled without prejudice or disclaimer in the preliminary amendment filed with the application on February 23, 2004. The Applicant reserves the right to pursue all canceled claims in a later-filed application. New claims 69-87 are added. Reconsideration is respectfully requested in view of the foregoing amendments and following remarks. Applicant respectfully submits that the Application is in condition for allowance.

II. THE REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

In numbered paragraphs 2-3 on pages 2-3 of the Office Action, claims 37-44 and 61-68 are rejected under 35 U.S.C. § 112, second paragraph, as “being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” Specifically, the Office Action states that “[t]he disclosure does not provide a specific algorithm for performing the functionality corresponding to all of the means recited throughout claims 37-44 and 61-68.” Office Action, page 2, numbered paragraph 3. The rejection is respectfully traversed. Nevertheless, in the interest of expediting prosecution, claims 37-44 and 61-68 are hereby canceled without prejudice or disclaimer, thus rendering the rejection moot.

III. THE REJECTION UNDER 35 U.S.C. § 101

In numbered paragraphs 4-5 on pages 3-5 of the Office Action, claims 21-68 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter on various grounds. The rejection is respectfully traversed. Nevertheless, in the interests of expediting prosecution, claims 21 and 29 are hereby amended to more particularly recite the features of the computer-readable medium for tax data collection and the method for tax data collection, respectively.

Furthermore, the specification is amended to remove the recitation of a “carrier wave” as an example of a computer-readable medium. Additionally, claims 37-68 are hereby canceled without prejudice or disclaimer. Accordingly, the Applicant respectfully requests reconsideration and withdrawal of the rejections for at least the following three reasons.

First, the rejection of claims 21-28 and 45-52 as being directed to non-statutory subject matter is believed to be moot. By this Amendment, the specification is amended to remove “carrier wave” as an example of a computer-readable medium. *See* page 2, *supra*. Furthermore, claims 45-52 are hereby canceled without prejudice or disclaimer. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Second, with regard to claims 29-36, it is respectfully submitted that the claims are, in fact, tied to a particular machine or apparatus so as to constitute patentable subject matter under Section 101 and in accordance with the machine-or-transformation test of *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008). Amended claim 29, for example, recites:

A method for tax data collection *by an electronic intermediary* comprising:
 receiving electronically information *by said electronic intermediary* from a taxpayer or an authorized tax return preparer of said taxpayer, wherein said received information comprises information on a tax data provider and taxpayer identification information;
 connecting automatically and electronically *said electronic intermediary* to said tax data provider, wherein *said electronic intermediary* connects automatically and electronically to said tax data provider based on said received information;
 collecting automatically and electronically tax data *by said electronic intermediary* from said tax data provider, wherein said tax data is taxpayer specific tax data;
 processing automatically and electronically *by said electronic intermediary* said tax data collected electronically from said tax data provider to obtain processed tax data; and
 preparing automatically and electronically an electronic tax return *by said electronic intermediary* using said processed tax data.

(emphasis added). The specification clearly recites that the term “electronic intermediary” is defined as referring to “a data processing system comprising a general purpose computer and a computer program.” Page 9, lines 16-17. A data processing system comprising a general

purpose computer and a computer program is a machine or apparatus under Section 101. In other words, the recited electronic intermediary is “a concrete thing, consisting of parts, or of certain devices and combination of devices.” *In re Nuijten*, 500 F.3d 1346, 1355, 84 USPQ2d 1495 (Fed. Cir. 2007); *see also In re Ferguson*, 2009 WL 565074, at *5 (Fed. Cir. March 6, 2009) (using this quote from *In re Nuijten* in a discussion of the machine branch of the machine-or-transformation test). Both the preamble and body of claim 29 positively recite the electronic intermediary. Moreover, each and every recited step in claim 29 is performed by the electronic intermediary such that the recitation of such particular machine or apparatus clearly constitutes more than mere insignificant post-solution activity. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested. Claims 53-60 are hereby canceled without prejudice or disclaimer, thus rendering the rejection moot with respect to these claims.

Third, the Office Action rejects claims 37-44 and 61-68 as being directed to non-statutory subject matter, apparently for the same reasons such claims are also rejected as being indefinite under 35 U.S.C. § 112, second paragraph. *See* Office Action, page 5. By this Amendment, claims 37-44 and 61-68 are hereby canceled without prejudice or disclaimer, thus rendering the rejection moot with respect to these claims.

In view of the foregoing, the Applicant respectfully submits that at least claims 21-36 recite statutory subject matter under 35 U.S.C. § 101 and requests that the rejection be withdrawn. New claims 69-72 depend from claim 21 and are submitted as being directed to patentable subject matter for at least the same reasons. New claims 73-76 depend from claim 29 and are submitted as being directed to patentable subject matter for at least the same reasons. Reconsideration and withdrawal of the rejections are respectfully requested.

IV. THE REJECTION UNDER 35 U.S.C. § 102

In numbered paragraphs 6-7 on pages 5-9 of the Office Action, claims 21-27, 29-35, 37-43, 45-51, 53-59, and 61-67 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 7,010,507 to Anderson *et al.* (“Anderson”). The Applicant respectfully traverses the rejection. Nevertheless, in the interests of expediting prosecution, claims 21 and 29 are hereby amended to more particularly recite the features of the computer-readable medium for tax data collection and the method for tax data collection, respectively. Furthermore, claims 37-68 are hereby canceled without prejudice or disclaimer, thus rendering the rejection moot with regard to

these claims. Reconsideration and withdrawal of the rejection are respectfully requested in view of the foregoing amendments and following remarks.

“A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987) (emphasis added); M.P.E.P. § 2131. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Here, the Applicant respectfully submits that Anderson fails to teach each and every element set forth in at least independent claims 21 and 29.

Claim 21, as amended, recites:

A computer-readable medium embodying a computer program for tax data collection by an electronic intermediary, said computer program comprising code segments for:

- receiving electronically information by said electronic intermediary from a taxpayer or an authorized tax return preparer of said taxpayer, wherein said received information comprises information on a tax data provider and taxpayer identification information;***
- connecting automatically and electronically said electronic intermediary to said tax data provider, wherein ***said electronic intermediary connects automatically and electronically to said tax data provider based on said received information;***
- collecting automatically and electronically tax data by said electronic intermediary from said tax data provider, wherein said tax data is taxpayer specific tax data;
- processing automatically and electronically by said electronic intermediary said tax data collected electronically from said tax data provider to obtain processed tax data; and
- preparing automatically and electronically an electronic tax return by said electronic intermediary using said processed tax data.

Claim 29 recites a method for tax data collection by an electronic intermediary which includes the same recited steps. Thus, both claims 21 and 29, as amended, now recite in relevant part “receiving electronically information by said electronic intermediary from a taxpayer or an authorized tax return preparer of said taxpayer, wherein said received information comprises information on a tax data provider and taxpayer identification information” as well as that “said

electronic intermediary connects automatically and electronically to said tax data provider based on said received information.” Support for the “receiving electronically” recitation can be found, for example, at page 9, line 13 through page 10, line 9; page 10, line 16 through page 11, line 14; and page 12, lines 2-5. *See also* FIG. 1, step 11, and FIG. 2. Similar amendments were made to the claims in the *ex parte* reexamination proceedings of the parent patents of the instant application, which amendments were deemed by the Office as patentably distinguishable over Anderson. *See* Reexam Control Nos. 90/006,713 (U.S. Patent No. 6,202,052) and 90/006,969 (U.S. Patent No. 6,697,787).

A. Anderson’s System

Anderson purportedly relates to an “[e]lectronic data processing system which enables tax filers who electronically file tax returns to early use of their refund amount through an increased credit card credit limit with the tax payers credit card account” (Abstract). According to the Background Section of Anderson, other mechanisms for processing an advance payment of an expected tax refund amount were known (e.g., Refund Anticipation Loans – *see, e.g.*, U.S. Patent Nos. 4,890,228 & 5,193,057 to Longfield), but such systems still had some disadvantages. Anderson’s system purportedly solves these perceived deficiencies by increasing the credit limit associated with a tax payer’s credit card by the expected refund amount. Due to the relatively sparse, ambiguous, and inconsistent disclosure of Anderson, however, the Applicant submits that it is difficult to determine exactly how the system operates. Accordingly, the following figure (FIG. A) was prepared in an attempt to understand the Anderson system.

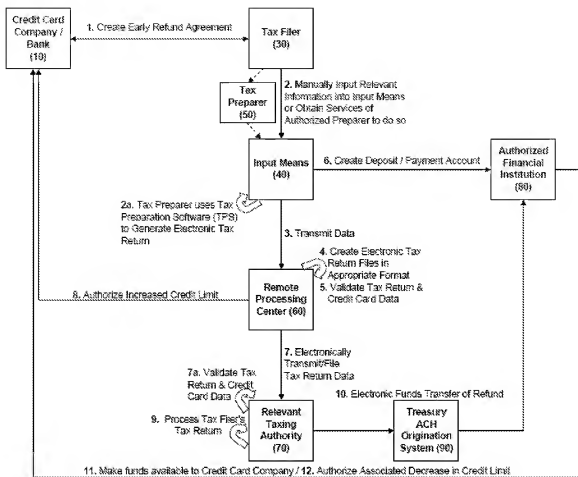


FIG. A

According to Anderson, “[t]he tax filer 30 enters into an early refund agreement 20, 100 with his or her credit card bank 10 . . . to increase the tax filer’s credit card credit limit by that refund amount.” Column 3, lines 8-11. This is reflected in FIG. A above as reference number “1.” There is nothing to indicate that the offer and acceptance of this agreement takes place electronically. Upon entering into the agreement 20, the tax filer 30 “can then initiate the data submission process.” Column 3, lines 20-22. The tax filer 30 uses “input means 40” to manually input the relevant information 110, which may include, inter alia, “tax filer tax return information (such as wages earned, etc.)” and “refund amount information.” See column 3, lines 22-30. Alternatively, a tax filer 30 “may obtain the services of an authorized preparer 50 who may assist in data input processing and provide a software system for enabling electronic filing.” Column 3, lines 30-33. Both scenarios are shown as reference number “2” in FIG. A. In the case where the tax filer obtains the services of an authorized preparer, “Tax Preparation Software

(TPS) is used by the tax preparer to generate the electronic tax return” (column 3, lines 46-48) wherein “[t]he typical information needed for insertion by the tax preparer into the electronic tax return is basically the same as needed for a non-electronic tax return including such information as the tax filer’s W2(s) and other miscellaneous tax liabilities and assets information” (column 3, lines 48-53). This is reflected in FIG. A as reference number “2a.” Thus, at least one of the tax filer 30 or the tax preparer 50 manually enters the relevant information. Anderson does not teach or suggest any electronic transfer of data between the tax filer 30 and the tax preparer 50.

“Once data input is complete, the data [i.e., the electronic tax return prepared by the Tax Preparation Software on input means 40] is transmitted to a remote data processing center 60, preferably via a computer network.” Column 3, lines 34-36; *see* FIG. A, reference number “3.” At the remote data processing center 60, “a program process is executed to create electronic tax return files which are in a form accepted by the IRS or relevant taxing authority.” Column 3, lines 37-39; *see* FIG. A, reference number “4.” One of ordinary skill in the art would recognize that Anderson’s remote data processing center 60 is merely a “Transmitter” as defined in Section 3.3 of IRS Publication 1345 (Rev. 8-95), “Handbook for Electronic Filers of Individual Income Tax Returns Tax Year 1995,” a copy of which is submitted herewith in an Information Disclosure Statement (IDS). In the context of electronic filing, a “Transmitter” is defined as “a firm, organization or individual who transmits electronic tax returns directly to the IRS Data Communications Subsystem” and includes “entities which receive information to be reformatted and sent to IRS, i.e., third party Transmitters.” *Id.*

Next, Anderson states that “[i]t is necessary to validate tax return data and credit card data 120” and explains that “[v]alidation of tax return data, including mathematical checking, can be performed by . . . the remote data processing center 60.” Column 3, lines 54-57; *see* FIG. A, reference number “5.” “Once tax return data and credit histories are preferably validated, a deposit/payment account 130 is created at an authorized financial institution 80.” Column 3, lines 60-62; *see* FIG. A, reference number “6.” Anderson also states that “[t]he tax preparer will arrange for a deposit tax refund account to be opened at a specified ACH bank.” Column 4, lines 16-17.

“With the creation of the deposit/payment account, the tax return data is electronically filed with the IRS or relevant taxing authority 140.” Column 4, lines 4-6; *see* FIG. A, reference number “7.” “Validation of tax return data . . . can be performed by a data processor means at

the IRS Center 70.” Column 3, lines 55-57; *see* FIG. A, reference number “7a.” “A program means of the remote processing center initiates a credit card credit limit increase in the amount of the expected refund” Column 3, lines 60-62; *see* FIG. A, reference number “8.”

“Upon processing the tax filer’s tax return, the IRS transmits the refund, by electronic funds transfer, to the tax filer’s deposit/payment account.” Column 4, lines 40-42; *see* FIG. A, reference numbers “9” and “10.” “The authorized financial institution 80, where the account is located, then makes funds available to the credit card account 10 of the tax filer and decreases the credit card credit limit 170 by the previously increased amount.” Column 4, lines 42-46; *see* FIG. A, reference numbers “11” and “12.”

With the foregoing in mind, the Applicant believes that at least claims 21 and 29 are not anticipated by Anderson for at least the following three reasons.

B. Anderson Fails to Teach or Suggest At Least the Recited Steps of “receiving electronically information...,” “connecting automatically and electronically...” and “collecting automatically and electronically...”

First, Anderson fails to teach or suggest at least the recited steps of

- receiving electronically information by said electronic intermediary from a taxpayer or an authorized tax return preparer of said taxpayer, wherein said received information comprises information on a tax data provider and taxpayer identification information;
- connecting automatically and electronically said electronic intermediary to said tax data provider, wherein said electronic intermediary connects automatically and electronically to said tax data provider based on said received information; and
- collecting automatically and electronically tax data by said electronic intermediary from said tax data provider, wherein said tax data is taxpayer specific tax data.

In rejecting claim 21, for example, the Office Action apparently aligns the entities recited in the foregoing clauses (i.e., the “electronic intermediary” and the “tax data provider”) with entities described in Anderson. *See, e.g.*, Office Action page 5, numbered paragraph 7 (“The tax filer provides tax data to the authorized preparer who utilizes a remote data processing center to facilitate preparation and filing of an electronic tax return on behalf of the tax filer”).

Specifically, the Office Action appears to align the recited “electronic intermediary” with Anderson’s “remote data processing center 60.” The Office Action also appears to align the recited “tax data provider” with one of Anderson’s “tax filer 30” or the “authorized preparer 50”. In view of the recitation that the electronic intermediary receives electronically information from a taxpayer or an authorized tax return preparer of said taxpayer, and that the electronic intermediary connects automatically and electronically to the tax data provider based on the received information, however, the Applicant respectfully submits that it is unreasonable to consider Anderson’s “tax filer 30” or “authorized preparer 50” to be the recited “tax data provider.”

During patent examination, claims must be given their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) (citation omitted); M.P.E.P. § 2111. Furthermore, “broadest reasonable interpretation” is understood to mean construing the words “in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.” *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Although it is improper to import claim limitations from the specification, claims cannot be read in a vacuum. *See* M.P.E.P. § 2111.01. Thus, during examination, a broad interpretation of a claim term that is inconsistent with the specification would not be considered “reasonable.”

According to page 9, lines 18-19 of the instant specification, “[t]he term ‘tax data provider’ refers to each party that has tax information relevant to the taxpayer’s tax liability or tax reporting obligations.” This definition is followed by a list of non-limiting examples which are not intended to limit the definition, but nonetheless serves to illuminate the type of party that might qualify as a “tax data provider.” The term “taxpayer,” on the other hand, is separately defined as “an individual or other entity, such as a trust, estate, corporation, or partnership, who has tax liability or must file a tax return.” *See* page 9, lines 14-16 of the instant specification. FIG. 2 also visually depicts the distinction between the taxpayer and several examples of the taxpayer’s “tax data providers.” Thus, each of these entities is separately defined in the specification such that the taxpayer and/or the taxpayer’s tax return preparer cannot reasonably be considered to be “tax data providers.”

Furthermore, there are several statements throughout the specification that would be rendered moot, or at least incomprehensible, if a taxpayer or taxpayer's tax return preparer are considered to be a "tax data provider." Some examples, taken from the description of step 11 starting at page 9, line 13, are as follows:

- "In step 11, the taxpayer 20 provides the electronic intermediary 21 with information on tax data providers." Page 9, lines 13-14.
- "[T]he taxpayer could specifically identify the tax data providers and could include information on how to contact the tax data providers electronically." Page 10, lines 6-8.
- "Additionally, the taxpayer can provide the electronic intermediary with authorization to contact and receive information from the tax data providers." Page 10, lines 9-11.
- "The taxpayer can provide the electronic intermediary with the information on the tax data providers in a number of ways. For example, the electronic intermediary could prompt the taxpayer for the information, and the taxpayer could provide the information using an input means." Page 10, lines 16-19.
- "In the preferred embodiment of the invention, the taxpayer has control over the electronic intermediary. For example, the electronic intermediary could be a pre-packaged computer program embodied on a computer-readable medium available in a retail market. In this case, the taxpayer purchases the electronic intermediary from the retail market and installs the electronic intermediary on the taxpayer's general purpose computer. The taxpayer then provides the information on the tax data providers as well as other information to the electronic intermediary installed on the taxpayer's general purpose computer." Page 11, lines 4-11.
- "In an alternative embodiment of the present invention, the electronic intermediary is controlled by a tax return preparer institution, such as a professional tax preparation company, an accounting firm, or an individual accountant. In this embodiment, the tax return preparer is authorized by the taxpayer to collect, compute, prepare, and file the taxpayer's tax return, and to debit or credit the taxpayer's bank account for any tax liability or refund, respectively." Page 11, lines 12-17.
- "Because the tax return preparer controls the electronic intermediary in this alternative embodiment, the tax return preparer ensures that the electronic intermediary receives the appropriate information required, such as the electronic location of the tax data providers, and information to determine whether the taxpayer has a special tax case." Page 12, lines 2-5.

Additionally, the recitations of "connecting automatically and electronically . . ." and "collecting automatically and electronically . . ." correspond, for example, to step 12 in FIG. 1. In the description of step 12 (*see* page 12, line 6 through page 13, line 17; *see also* FIG. 2), the

electronic intermediary connects automatically and electronically to each tax data provider that has tax data pertaining to the taxpayer and collects automatically and electronically tax data from the tax data providers. The tax data providers recited at page 9, line 19 through page 10, line 2 and shown in FIG. 2 are labeled as, for example, “Taxpayer’s Employers 22,” “Taxpayer’s Banks 23,” “Taxpayer’s Other Tax Data Providers 26,” etc. This is believed to clearly support the argument that a “taxpayer” and/or a taxpayer’s “tax return preparer” cannot reasonably be considered to be “tax data providers” within the context of the instant patent application.

With the understanding that a taxpayer or a taxpayer’s tax preparer cannot be a “tax data provider,” the features of “connecting automatically and electronically said electronic intermediary to said tax data provider” and “collecting automatically and electronically tax data from said tax data provider” are believed to be patentably distinguishable over Anderson. According to instant specification, page 13, lines 13-17:

Hence, *with the electronic collection of tax data as in step 12*, the invention *eliminates the current requirement that a taxpayer manually collect the tax data*, eliminates the current requirement that *a taxpayer manually enter such tax data onto a tax return or into a computer*, and eliminates the need for all, or virtually all, intermediate hard copies of tax data, thereby saving paper, time, and cost. (emphasis added).

If the steps of “connecting automatically and electronically...” and “collecting automatically and electronically...” were actually taught by Anderson, Anderson would not require (1) that **the tax filer 30 utilize an input means 40 for manually inputting relevant information 110** (see Anderson, column 3, lines 22-30) or, alternatively, (2) that **the tax filer obtain the services of an authorized preparer 50 to assist in manual data input** (see Anderson, column 3, lines 30-32 and 46-53). Thus, Anderson fails to teach or suggest at least the features of “receiving electronically information . . .,” “connecting automatically and electronically . . .” and “collecting automatically and electronically . . .” as recited in at least claims 21 and 29.

C. Anderson’s Remote Data Processing Center Cannot Reasonably Be Considered to be the Recited “Electronic Intermediary”

Second, in addition to the fact that Anderson’s tax filer 30 and tax preparer 50 cannot be reasonably considered to be a “tax data provider,” the Applicant also respectfully submits that

Anderson's remote data processing center 60 cannot be considered to be the recited "electronic intermediary." As a result, Anderson fails to teach at least the recited features of "processing automatically and electronically by said electronic intermediary said tax data collected electronically from said tax data provider to obtain processed tax data" and "preparing automatically and electronically an electronic tax return by said electronic intermediary using said processed tax data."

As previously noted, in rejecting claim 21, for example, the Office Action apparently aligns the recited entities (i.e., the "electronic intermediary" and the "tax data provider") with the "remote data processing center 60" and one of the "tax filer 30" or the "authorized preparer 50," respectively. *See, e.g.*, Office Action page 5, numbered paragraph 7 ("The tax filer provides tax data to the authorized preparer who utilizes a remote data processing center to facilitate preparation and filing of an electronic tax return on behalf of the tax filer"). The Applicant, however, respectfully disagrees and again points out that claim 21 recites a computer-readable medium comprising a computer program having code segments for performing several steps, each of which are expressly recited as being performed by the electronic intermediary. Thus, although Anderson's remote data processing center 60 may arguably satisfy the broad definition of "electronic intermediary" reciting in the specification ("a data processing system comprising a general purpose computer and a computer program"), it is respectfully submitted that the remote data processing center 60 does not perform at least the functions recited in the "processing" and "preparing" steps recited, for example, in claim 21.

The step of "processing automatically and electronically by said electronic intermediary said tax data collected electronically from said tax data provider to obtain processed tax data" corresponds, for example, to step 13 shown in FIG. 1 and described at page 13, line 18 through page 14, line 12, which states, *inter alia*, that "the electronic intermediary processes the tax data by performing the appropriate tax computations." Furthermore, the instant specification states that "[n]on-limiting examples of appropriate tax computations include: addition, subtraction, multiplication, and division to determine the taxpayer's gross income, relevant deductions, net taxable income, and tax liability." Page 14, lines 6-8. As an illustration of processing automatically and electronically said tax data to obtain processed tax data, the electronic intermediary compiles the home mortgage interest paid by the taxpayer and reported as tax data by the financial institutions to the electronic intermediary and determines the taxpayer's relevant

deduction for the home mortgage interest paid to the financial institutions. *See* page 14, lines 8-12.

On the other hand, Anderson's remote data processing center 60 merely executes a program process "to create electronic tax return files which are in a form accepted by the IRS or relevant taxing authority." Anderson, column 3, lines 37-39. Nowhere does Anderson state that the remote data processing center 60 processes the tax data by performing the appropriate tax computations. Instead, according to Anderson, "[t]he Tax Preparation Software (TPS) is used by the tax preparer to generate the electronic tax return" (column 3, lines 46-48). The Office Action, however, aligns Anderson's "tax preparer" with the recited "tax data provider." Thus, the Applicant respectfully submits that Anderson's remote data processing center 60 merely serves as a "third party Transmitter," that is an entity "which receive[s] information to be reformatted and sent to IRS" as provided in Section 3.3 of IRS Publication 1345 (Rev. 8-95), "Handbook for Electronic Filers of Individual Income Tax Returns Tax Year 1995," and cannot reasonably be considered to be the recited electronic intermediary. Accordingly, it is respectfully submitted that Anderson fails to teach or suggest at least the feature of "processing automatically and electronically by said electronic intermediary said tax data collected electronically from said tax data provider to obtain processed tax data" as recited in at least claims 21 and 29.

Likewise, the step of "preparing automatically and electronically an electronic tax return by said electronic intermediary using said processed tax data" corresponds, for example, to step 14 shown in FIG. 1 and described at page 14, lines 13-18, which states that "the electronic intermediary prepares electronic tax returns using the processed tax data from step 13." Anderson's remote data processing center 60, on the other hand, merely executes a program process "to create electronic tax return files which are in a form accepted by the IRS or relevant taxing authority." Anderson, column 3, lines 37-39. Nowhere does Anderson state that the remote data processing center 60 prepares electronic tax returns. Instead, according to Anderson, "[t]he Tax Preparation Software (TPS) is used by the tax preparer to generate the electronic tax return" (column 3, lines 46-48). The Office Action, however, aligns Anderson's "tax preparer" with the recited "tax data provider." Thus, the Applicant respectfully submits that Anderson's remote data processing center 60 merely serves as a "third party Transmitter," that is an entity "which receive[s] information to be reformatted and sent to IRS" as provided in Section 3.3 of

IRS Publication 1345 (Rev. 8-95), "Handbook for Electronic Filers of Individual Income Tax Returns Tax Year 1995," and cannot reasonably be considered to be the recited electronic intermediary. Accordingly, it is respectfully submitted that Anderson fails to teach or suggest at least the feature of "preparing automatically and electronically an electronic tax return by said electronic intermediary using said processed tax data" as recited in at least claims 21 and 29.

D. Anderson Fails to Teach "Automatically and Electronically"

Third, Anderson fails to teach or suggest steps or features that are performed "automatically and electronically" as recited in each of claims 21 and 29. Here, claim 21, for example, recites various steps performed "automatically and electronically." Nothing in Anderson, however, indicates that any of the steps or functions are performed automatically and electronically. The term "automatic" or "automatically" does not appear anywhere in Anderson, nor is there any other language that might imply automation. Thus, it is respectfully submitted that Anderson fails to teach or suggest each of the features or steps recited as being performed "automatically and electronically" in at least claims 21 and 29.

Accordingly, claims 21 and 29, as amended, are believed to be allowable over Anderson. Claims 22-28 and 69-72 depend variously from claim 21 and are believed to be patentable for at least the same three reasons. Likewise, claims 30-36 and 73-76 depend variously from claim 29 and are believed to be patentable for at least the same three reasons.

V. THE REJECTION UNDER 35 U.S.C. § 103

In numbered paragraphs 8-9 on pages 10-11 of the Office Action, claims 28, 36, 44, 52, 60, and 68 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson, as applied to claims 21, 29, 37, 45, 53, and 61, in view of Official Notice taken by the Examiner. The Applicant respectfully traverses the rejection. Claims 28 and 36 depend from claims 21 and 29, respectively, and are respectfully submitted as being patentable over Anderson for at least the same reasons presented above. The Office's taking of Official Notice does not remedy the deficiencies of Anderson. Furthermore, by this Amendment, claims 44, 52, 60, and 68 are canceled without prejudice or disclaimer, thus rendering the rejection moot with respect to these claims. Reconsideration and withdrawal of the rejection are respectfully requested.

VI. NEW CLAIMS 69-87

By this Amendment, new claim 77 is added and recites an apparatus for tax data collection. The apparatus is believed to be allowable for at least the reasons set forth above with regard to claims 21 and 29. Support for the recitations in new claim 77 can be found as follows:

An apparatus for tax data collection (*see, e.g.*, page 7, lines 9-11), comprising:

a computer (*see, e.g.*, page 9, lines 16-18) having:

at least one of a keyboard or a mouse (*see, e.g.*, page 10, lines 19-20); and

a computer-readable medium embodying a computer program for tax data collection by the computer, the computer program comprising code segments (*see, e.g.*, page 7, line 20 through page 8, line 8) for:

receiving electronically information by the computer from a taxpayer or an authorized tax return preparer of said taxpayer, wherein the taxpayer or the authorized tax return preparer of the taxpayer provides the information using the keyboard and/or the mouse of the computer, and wherein the received information comprises information on a tax data provider and taxpayer identification information (*see, e.g.*, page 9, line 13 through page 10, line 9; page 10, line 16 through page 11, line 14; and page 12, lines 2-5; *see also* FIG. 1, step 11, and FIG. 2);

connecting automatically and electronically the computer to the tax data provider using an electronic data network (*see, e.g.*, page 12, lines 6-9; page 12, line 17 through page 13, line 1 *see also* FIG. 1, step 12, and FIG. 2), wherein the computer connects automatically and electronically to the tax data provider based on the received information;

collecting automatically and electronically tax data by the computer from the tax data provider using the electronic data network, wherein the tax data is taxpayer specific tax data (*see, e.g.*, page 12, line 6 through page 13, line 1; *see also* FIG. 1, step 12, and FIG. 2);

processing automatically and electronically by the computer the tax data collected electronically from the tax data provider to obtain processed tax data (*see, e.g.*, page 13, line 18 through page 14, line 12; *see also* FIG. 1, step 13); and

preparing automatically and electronically an electronic tax return by the computer using the processed tax data (*see, e.g.*, page 14, lines 13-18; *see also* FIG. 1, step 14).

New claims 69-72 are added and depend from claim 21. New claims 73-76 are also added and depend from claim 29. New claims 84-87 are also added and depend from new claim 77. Support for claims 69-76 and 84-87 can be found, for example, as follows:

Claims 69, 73, 84 – *see, e.g.*, page 10, lines 9-11;

Claims 70, 74, 85 – *see, e.g.*, page 10, lines 3-9;

Claims 71, 75, 86 – *see, e.g.*, page 10, lines 11-12; page 12, line 5; and

Claims 72, 76, 87 – *see, e.g.*, page 10, lines 6-8; page 12, lines 2-5.

New claims 78-83 depend variously from claim 77 and reflect, for example, language recited in original claims 22-28.

VII. RESCINDING PRIOR DISAVOWALS OF CLAIM SCOPE

Pursuant to *Hakim v. Cannon Avent Group, Plc*, 479 F.3d 1313 (Fed. Cir. 2007), the Examiner is respectfully advised that any previous disavowals of claim scope made during prosecution in this application or in a related application, as well as during the *ex parte* reexamination proceedings on the parent patents, are hereby rescinded. Therefore, any prior art that necessitated such previous disavowels may need to be revisited.

VIII. CONCLUSION

Claims 21-36 and 69-87 are pending in the application. All of the stated grounds of rejection are believed to have been properly overcome, traversed, or rendered moot. The Applicant respectfully requests that the Examiner reconsider all presently outstanding objections rejections and that they be withdrawn. The Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. An early notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that a personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Prompt and favorable consideration on the merits is respectfully requested.

Respectfully submitted,

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By /Ryan M. Flandro/
Michael A. Sartori, Ph.D.
Registration No. 41,289
Ryan M. Flandro
Registration No. 58,094
VENABLE LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Telephone: (202) 344-4000
Telefax: (202) 344-8300

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